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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,002	07/02/2003	Manfred Hoppe	1997/D004C	4485

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,002

Applicant(s)

HOPPE ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/2/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/271,820
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/2/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The amendment of 7/2/03 adds an H to formula I without underlining. This amendment is objected to for the lack of underlining. See MPEP 1411 [R-3] Form of Specification 37 CFR 1.173.
2. The preliminary amendment of 7/2/03 has been entered. Claims 1-5 and 7-15 are pending.
3. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The preliminary amendment of 7/2/03 adds an H to the amino N of formula I making a nonionic quaternary amine group. This error is not identified in the declaration filed with the specification. The amendment to the claim adds H sub 6 C sub 5- which was not previously presented. It appears the subscripts were exchanged. This error is not identified in the specification.

See MPEP 1414 [R-3] Content of Reissue Oath/Declaration:

37 CFR 1.175. Reissue oath or declaration.

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

(b)

(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

(i) With any amendment prior to allowance; or

(ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph

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will overcome the rejection.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-5 and 7-15 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

4. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A. The instant claim 1, from which the other claims depend, recite a formula I which contains a nonionic, quaternary amine. The instant specification does not enable nor describe such a moiety.

B. The amendment to the claim adds H sub 6 C sub 5- which was not previously presented and would not appear to be possible to make.

5. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. The instant claim 1, from which the other claims depend, recite a formula I which contains a nonionic, quaternary amine. The instant specification does not enable nor describe such a moiety. New matter is not permitted in the reissue application.

B. The amendment to claim 1 adds H sub 6 C sub 5- which was not previously presented. New matter is not permitted in the reissue application.

6. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed substituents of ring A, does not reasonably provide enablement for all substituents which are possibly put on ring A. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. It would require undue experimentation to determine all of the infinite number of potential substituents for ring A which are encompassed by the instant claims and which would allow the invention to function as required. An astronomical number of the encompassed substituents are expected to result in compounds which do not function as required by the instant specification. It requires an infinite amount of experimentation therefore to determine which substituents are encompassed by the instant claims given the lack of teaching in this regard by the instant specification regarding the claims which are not commensurate in scope with the enabling specification.

7. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: The affect of the amendments adding a

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quaternary nonionic amine and the new moiety H sub 6 C sub 5- to the claims has the effect of adding scope to the claims which was not previously present. This is not appropriate at this time and requires the inventors to sign the declaration. See MPEP 1414, >III. < SUPPLEMENTAL OATH/DECLARATION IN BROADENING

REISSUE

A broadening reissue application must be applied for by all of the inventors (patentees), that is, the original reissue oath/declaration must be signed by all of the inventors. See MPEP § 1414.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-5 and 7-15 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

8. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. See MPEP 1412.03 cited below. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

See MPEP 1412.03 [R-3] Broadening Reissue Claims

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35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues:

No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.

>I. < MEANING OF "BROADENED REISSUE CLAIM"

A broadened reissue claim is a claim which enlarges the scope of the claims of the patent, i.e., a claim which is greater in scope than each and every claim of the original patent. If a disclaimer is filed in the patent prior to the filing of a reissue application, the disclaimed claims are not part of the "original patent" under 35 U.S.C. 251. The Court in Vectra Fitness Inc. v. TNWK Corp., 49 USPQ2d 1144, 1147, 162 F.3d 1379, 1383 (Fed. Cir. 1998) held that a reissue application violated the statutory prohibition under 35 U.S.C. 251 against broadening the scope of the patent more than 2 years after its grant because the reissue claims are broader than the claims that remain after the disclaimer, even though the reissue claims are narrower than the claims that were disclaimed by the patentee before reissue. The reissue application was bounded by the claims remaining in the patent after a disclaimer is filed. A claim of a reissue application enlarges the scope of the claims of the patent if it is broader in at least one respect, even though it may be narrower in other respects.

A claim in the reissue which includes subject matter not covered by the patent claims enlarges the scope of the patent claims.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combinations of the teachings of JP 60-015460 Suzuki et al. (applicant supplied abstract referenced), GB 1582743 Bennett et al. which appears to be an equivalent to DE 2818653 cited by the patent under reissue at column 1, lines 49-51 as teaching the instantly claimed component II, and GB 2030169 Altermatt et al..

Suzuki discloses the instantly claimed component I of claims 1-5 and 7-15 as a heat stable dye. Bennett discloses the instantly claimed component II as stated in the patent under reissue. See the entire document, particularly page 1, lines 1-36; page 2, lines 1-16; page 3, lines 1-65; page 4, lines 1-65, particularly 1-2 and 17-24; and the remainder of the document. Altermatt is cited as giving information relating to how various substituents affect the colors of the dyes of the instantly claimed formula II and further emphasizing the general point made by Bennett, page 4, lines 17-24 and to further establish the general state of the art regarding mixing of various dyes. See the entire document, particularly the table showing what color the dyes having the various substituents are, particularly but not limited to page 6, dyes 15-16. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients because Suzuki and Bennett show that the instantly claimed dyes are known, Bennet, page 4, lines 17-21 states that their dyes may be used with the known coloring matters including azo dyes, Suzuki's dyes are azo dyes and would have been expected to impart their known heat stability and colors to the mixture of Bennet. The skilled artisan is generally aware of the desirability to combine dyes as shown by the entirety of the art cited above. Based on Beers Law and other well known undergraduate level

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spectroscopic means and theories, the skilled artisan would have expected the dye compositions of the instant claims to give a combination of the known colors of these dyes, in proportion to the amounts thereof used, in a manner such that the color, shade, hue, etc. of the final dye composition would have been predictable to the ordinary skilled artisan. This concept is further evidenced by the combination of various dyes many ordinary people have done to achieve a desired color such as mixing red and blue dyes to get purple of a desired shade, hue, and chroma. Since the above discussed dyes are all of a similar backbone and similar HLBs, they are expected to be compatible with each other such that they will not block, separate, and do the other things which dyes should not do and which are the subject of general textbooks in the art. There is no showing of unexpected results stemming from the instantly claimed combinations of materials and the amounts thereof in a manner commensurate in scope with the cited prior art and the instant claims. In re Lindner, 173 USPQ 356, (CCPA 1972) is cited for the general concept that a mixture of components which are of the same function is expected to give that same function to further support the above rejection's combination of references. For the above reasons, the instantly claimed amounts of ingredients would appear to give only predictable results and the ordinary skilled artisan would have been motivated to use them if they desired the particular color, shade, hue, chroma, etc. which these amounts would provide. In simplified terms, if one wanted dark purple, they would know to mix dark blue in a large amount with red in a reduced amount. Bennett, page 4, lines 1-6 shows the method of mixing the above discussed dyes of the instant claims 10 and 14-15 to be generally known regarding using water, dispersant and dyes. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use this method to mix the above discussed dye mixtures of the instant claims because it is the

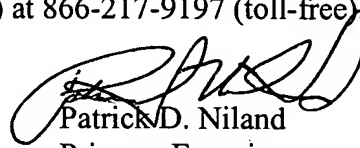
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conventional means for dispersing such disperse dyes as shown by Bennett. Bennett also shows the instantly claimed dying and printing steps and the article resulting therefrom. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use this method to dye or print articles using the above discussed dye mixtures of the instant claims because it is the conventional means for dying and printing such articles as shown by Bennett.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)


Patrick D. Niland
Primary Examiner
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